

REMARKS

Claims 1-8 have been examined and rejected. Claims 9-15 have been added by this Amendment. Accordingly, Claims 1-15 are all the claims pending in this application.

AMENDMENTS TO THE CLAIMS

Claims 1-8 have been amended as shown above. Claims 9-15 are added by this Amendment.

Claims 2 and 4 have been amended to incorporate the limitations of now-cancelled claim 1.

Claims 5-8 have been amended to correct dependencies in view of the amendments to claims 2 and 4 and to correct a minor typographical error. The amendments to claims 5-8 made herein are editorial amendments made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 5-8 were not made for reasons of patentability.

Claims 9-14 correspond to claims 6-8, however the dependencies of claims 9-14 differ. Similarly, claim 15 corresponds to claim 5, however claim 15 incorporates the limitations of claim 4.

OBJECTIONS TO THE CLAIMS

Applicant respectfully submits that the Amendment to claim 3 overcomes the Examiner's objection to this claim.

35 U.S.C. § 112 REJECTIONS

Applicant respectfully submits that, in view of the amendments to claims 2 and 4 above, the Examiner's rejections under 35 U.S.C. § 112 have been overcome.

ART REJECTIONS

A. Rejection of Claims 2-4 under 35 U.S.C. § 102(b) over U.S. Patent No. 4,644,807 to Mar ("Mar")

Claims 2-4 have been rejected under 35 U.S.C. § 102(b) over Mar. For at least the following reasons, Applicant respectfully traverses this rejection.

Claims 2 and 4 each recite, *inter alia*, a quantitative suction tip having "a fixed volume chamber with a predetermined volume and having a suction opening provided at a lower end thereof." The Examiner asserts that microporous filter 23/counterbore 24 corresponds to the recited fixed volume chamber.

Plunger 21 is not a quantitative sampling tip as recited in claims 2 and 4. Plunger 21 is used to eject materials from sample holding vial 11. (See column 4, lines 8-22). Further, materials are not withdrawn from sample holding vial 11 by suction, but rather by the downward pressure of plunger 21. (Id.). In other words, plunger 21 does not have a suction opening as recited in the rejected claims. Accordingly, Mar's plunger 21 fails to teach or suggest a quantitative suction tip as recited in claims 2 and 4. As claim 3 depends on claim 2, Applicant respectfully submits that claim 3 is patentable at least based on this dependency.

Further, with respect to claim 4, the Examiner has not made even a nominal attempt to show how Mar teaches an "engaging portion" as recited in claim 4. As it remains the Examiner's burden to show that each and every element of a rejected claim is taught or suggested by the prior art, Applicant respectfully submits that claim 4 is patentable over the cited

art at least because of a failure to show where such structure is taught or suggested in the prior art.

B. Rejection of Claims 2-4, 6 and 8 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,531,131 to Sabloewski (“Sabloewski”)

Claims 2-4, 6 and 8 have been rejected under 35 U.S.C. § 102(b) over Sabloewski. For at least the following reasons, application respectfully traverses this rejection.

Claim 2 recites a quantitative suction tip “wherein a fitting portion is formed on said fixed volume chamber for fitting with a periphery of the tip of said suction nozzle” and claim 4 recites a quantitative suction tip “wherein an engaging portion is formed over said through hole of said fixed volume chamber to engage the tip of said suction nozzle.”

The Examiner asserts that the recited fitting portion is taught by that portion of Salboewski’s plunger lift pipet just below cylinder 9. (See Office Action at p. 6). However, nothing in the area referenced in the Examiner’s annotated Figure 1 teaches or suggests the recited fitting portion. The cavity which the Examiner asserts corresponds to the claimed fixed volume chamber (see Office Action at p. 6) is formed in cone 2. (Col. 4, lines 21-22). This cavity, along with tube 10 and cylinder 9, define the stagnant volume of the pipet (col. 4, lines 31-32) and are not part of any suction nozzle. While the Examiner has not identified which portion of plunger lift pipet corresponds to the suction nozzle, Applicant respectfully submits that no portion of a cone 2 just below cylinder 9 meshes “fit[s] with a periphery of the tip of said suction nozzle.” For at least this reason, Applicant submits that claim 2 is patentable over Sabloewski.

Further, with respect to claim 4, the Examiner has not made even a nominal attempt to show how Sabloewski teaches an “engaging portion” as recited in claim 4. As it remains the

Examiner's burden to show that each and every element of a rejected claim is taught or suggested by the prior art, Applicant respectfully submits that claim 4 is patentable over the cited art at least because of a failure to show where such structure is taught or suggested in the prior art.

C. Rejection of Claims 2-4 and 6-8 under 35 U.S.C. § 102(e) over U.S. Patent Publication No. 2002/0081747 A1 to Jacobs ("Jacobs")

Claims 2-4 and 6-8 have been rejected under 35 U.S.C. § 102(e) over Jacobs. For at least the following reasons, application respectfully traverses this rejection.

Claims 2 and 4 each recite a qualitative suction tip having "a fixed volume chamber with a predetermined volume and having a suction opening provided at a lower end thereof ... wherein the cross-sectional area of said fixed volume chamber is constant throughout the length of said fixed volume chamber."

Jacobs teaches a cavity 118 having a tapered transition zone. (See Figs. 2A-C, 3). The Examiner asserts that this cavity 118 corresponds to the recited fixed volume chamber. However, cavity 118 does not have a cross-sectional area that is constant throughout the length (from top to bottom of the page as shown in Fig. 3) of the cavity. Accordingly, Applicant submits that claims 2 and 4 are patentable over Jacobs for at least this reason. As claims 3 and 6-8 depend from claims 2 and 4, Applicant submits that claims 3 and 6-8 are patentable over Jacobs at least based on this dependency.

D. Rejection of Claims 5-6 and 8 under 35 U.S.C. § 102(e) over U.S. Patent Publication No. 2003/0021734 to Vann ("Vann")

Claim 1 has been cancelled. Claims 2 and 4 have been amended to include each limitation of now-cancelled claim 1. As the Examiner has not rejected claims 2 and 4 in view of

Vann, Applicant submits that independent claims 2 and 4 and dependent claims 6 and 8 are patentable over Vann. As claim 5 and new claim 15 have been amended to incorporate each element of claims 2 and 4, respectively, Applicant submits that these claims are patentable for similar reasons.

E. Rejection of Claim 5 under 35 U.S.C. § 103(a) over Jacobs in view of U.S. Patent No. 6,592,825 to Pelc (“Pelc”)


Claim 5 has been rejected under 35 U.S.C. § 103(a) over Jacobs in view of Pelc. As claim 5 has been amended to include each limitation of claim 2 and as new claim 15 has been amended to include each limitation of claim 4, and as Pelc fails to cure the deficiencies of Jacobs discussed above with respect to claims 2 and 4, Applicant respectfully submits that claims 5 and 15 are patentable over the combination of Jacobs and Pelc.

CONCLUSION

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

 #50,855

Brandon M. White
Registration No. 52,354

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 12, 2005